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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,012	10/07/2003	Michael Furst	FURST, M-1	4718

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/680,012	<b>Applicant(s)</b> FURST, MICHAEL	
	<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 16 February 2007.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 2,7,9,11,14,16-21,24 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2,7,9,11,14,16-21,24 and 28-32 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/16/07 has been entered.

### ***Withdrawn Rejections***

2. The 35 U.S.C. 103 rejection of claims 1, 2, 7, 9, 11, 14, 16, 18, 20, 21, 24-26 and 28-30 over Wiercinski et al. in view of Hurst of record in the Final Office Action mailed 8/17/06, Pages 2-5, Paragraph #4 has been withdrawn due to the Applicant's amendment filed 2/16/07.
3. The 35 U.S.C. 103 rejection of claims 17 and 19 over Wiercinski et al. in view of Hurst and further in view of Zickell et al. of record in the Final Office Action mailed 8/17/06, Page 5, Paragraph #5 has been withdrawn due to the Applicant's amendment filed 2/16/07.
4. The 35 U.S.C. 103 rejection of claim 31 over Wiercinski et al. in view of Hurst and further in view of Kalkanoglu of record in the Final Office Action mailed 8/17/06, Pages 5-6, Paragraph #6 has been withdrawn due to the Applicant's amendment filed 2/16/07.

*Response to Arguments*

5. Applicant's arguments with respect to claims 2, 7, 9, 11, 14, 16-21, 24 and 28-32 have been considered but are moot in view of the new ground(s) of rejection, which are presented below.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 7, 9, 11, 14, 16, 18, 20, 21, 24, 28-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe (US 4,396,665) in view of Hurst (US 3,900,102) and in view of Wiercinski et al. (US 5,687,517) and in view of patent DE 20019212 U (refer to the translated abstract provided).

Regarding claims 14, 16, 18 and 32, Rowe discloses a film-bitumen combination comprising at least three layers wherein the at least three layers comprise a bituminous layer (Fig. 1, element 1 and col. 3, lines 9-10) and at least two film layers (Fig. 1, element 3) made from different materials (col. 4, lines 16-19), the bituminous layer being coated on the at least two film layers, the at least two film layers comprise a first film layer and a second film layer produced from a polyolefin, polypropylene, polyamide or polyethylene terephthalate (col. 4, lines 3-6), and the first film layer being located further away from the bituminous layer has a larger coefficient of elongation than the second film layer (col. 5, lines 63-65 and col. 6, lines 50-

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61), and each individual film layer is arranged in the combination in accordance with its thermal stability and its mechanical strength (col. 5, lines 63-65 and col. 6, lines 50-67). Rowe also discloses a barrier layer against mineral oils disposed between two adjacent layers of the at least two film layers (Fig. 1, element 2 and col. 5, lines 20-25).

However, Rowe fails to disclose a first edge of the at least two film layers projecting beyond the bituminous layer and a second edge of the at least two film layers being shorter than the bituminous layer. Additionally, Rowe fails to disclose the surface of a side of the combination facing away from the bituminous layer being treated to have non-slip properties by means of coating or by means of embossing. Also, Rowe fails to disclose the barrier layer having a layer of lacquer.

Hurst teaches that it is well known in the art to have a first edge of a film layer (Fig. 1, #2 at 10) project beyond a bituminous layer (Fig. 1, #4) and the second edge of the film layer be shorter (Fig. 1, #2 at 8) than the bituminous layer (Fig. 1, #4; also see col. 8, line 67 to col. 9, line 3) for the purpose of forming a continuous waterproofing membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate (col. 9, lines 59-67).

Wiercinski et al. teach that it is well known in the art to provide a skid resistant coating on the surface of a side of a film-bitumen combination facing away from the bituminous layer (col. 6, lines 46-54) for the purpose of minimizing skidding of foot traffic (col. 6, lines 46-48) and to emboss the surface of a side of a film-bitumen combination facing away from the

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bituminous layer (col. 3, lines 61-65) for the purpose of providing slip resistance to foot traffic (col. 4, lines 1-2 and line 21).

The patent DE 20019212 teaches a barrier layer of aluminum (1) being coated with a lacquer (3) on the side facing a bitumen layer (5) for the purpose of improving the adhesion between the aluminum and the bitumen layer and to provide protection against corrosion (see translated abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the edges of the at least two film layers 3 in Rowe to have the first edge of the film layers project beyond the bituminous layer and the second edge of the film layers be shorter than the bituminous layer as suggested by Hurst in order to form a continuous waterproofing membrane that does not contain and is not susceptible to the formation of channels for the flow or collection of water and that is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate. Additionally, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the surface of the side of the combination facing away from the bituminous layer in Rowe with a skid resistant coating as suggested by Wiercinski et al. in order to minimize skidding of foot traffic and provide non-slip properties, and also to emboss the surface of the side of the combination facing away from the bituminous layer in Rowe as suggested by Wiercinski et al. in order to further provide slip resistance to foot traffic. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the metal barrier layer in Rowe with a lacquer coating on the side facing the bitumen layer as suggested by patent DE

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20019212 in order to improve the adhesion between the metal layer and the bitumen layer and provide protection against corrosion.

Regarding claims 20 and 21, as shown above, Rowe fails to disclose the surface of the side of the combination facing away from the bituminous layer being treated to have non-slip properties. Wiercinski et al. was cited to teach that it is well known in the art to provide a skid resistant coating on the surface of a side of a film-bitumen combination facing away from the bituminous layer (col. 6, lines 46-54) for the purpose of minimizing skidding of foot traffic (col. 6, lines 46-48) and it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the surface of the side of the combination facing away from the bituminous layer in Rowe with a skid resistant coating as suggested by Wiercinski et al. in order to minimize skidding of foot traffic and provide non-slip properties. Even though Wiercinski et al. teach materials for the non-slip coating (col. 6, lines 46-57), Wiercinski et al. fail to teach specifically the non-slip coating being of a syndiotactic polystyrene and a thermoplastic elastomer with metallocene complex. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the surface of the side of the combination facing away from the bituminous layer in Rowe with a non-slip coating as suggested by Wiercinski et al. and to have the non-slip coating consist of a syndiotactic polystyrene and a thermoplastic elastomer with metallocene complex, since it has been held that a change in the material would be an unpatentable modification in absence of showing unexpected results and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 2, the at least two film layers 3 in Rowe have different coefficients of thermal expansion (col. 5, lines 63-65 and col. 6, lines 50-67). Regarding claim 7, in Rowe note at least one of the at least two film layers is produced from PET and is oriented (see col. 4, line 6 and lines 26-32). Regarding claim 9, in Rowe the at least two film layers 3 are laminated to the bituminous layer individually or together (col. 4, lines 16-19). Regarding claim 11, note in Rowe the at least one film layer facing the bituminous layer can be made of a polyamide or of PET (col. 4, lines 5-6), which is similar to those materials that make up the barrier layer disclosed in Applicant's invention, so inherently the film layer facing the bituminous layer will provide a mineral oil barrier. Regarding claim 24, note in Rowe an adhesive between two adjacent layers of the at least two film layers (col. 2, lines 50-52). Regarding claims 28-30, Rowe discloses a release liner (Fig. 1, element 4) of siliconized paper (col. 2, lines 56-62) on the surface of the bituminous layer facing away from the at least two film layers.

8. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 32 above, and further in view of Zickell (US 4,992,315).

Rowe, Wiercinski et al., Hurst and patent DE 200119212 teach the film-bitumen combination as shown above. However, Rowe fails to disclose a non-slip coating and an embossing of the surface on the side of the combination facing away from the bituminous layer being shorter at least along one edge of the combination.

Zickell et al. teaches that it is well-known in the art to have an embossed non-slip film (Fig. 3, #28) being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling (see col. 4, lines 63-66).



Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the surface of the side of the film-bitumen combination facing away from the bituminous layer in Rowe with an embossed non-slip film that is shorter at least along one edge of the combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 32 above, and further in view of Kalkanoglu (US 4,757,652).

Rowe, Wiercinski et al., Hurst and patent DE 200119212 teach the film-bitumen combination as shown above. However, Rowe fails to disclose the release liner 4 having several sections.

Kalkanoglu teaches that it is well-known in the analogous art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck (see col. 1, lines 5-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the release liner in Rowe to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck.

#### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Catherine A. Simone  
Examiner  
Art Unit 1772  
March 4, 2007



**NASSER AHMAD**  
**PRIMARY EXAMINER**